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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,338	05/15/2006	Krishnareddy Guddadarangavvnahally	52956.1.1	1023

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EXAMINER

CHEN, CATHERYNE

ART UNIT	PAPER NUMBER
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1655

MAIL DATE	DELIVERY MODE
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10/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,338	Applicant(s) GUDDADARANGAVVNAHALLY ET AL.	
	Examiner CATHERYNE CHEN	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 9-18 is/are pending in the application.
 4a) Of the above claim(s) 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/16/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Currently, Claims 1-4, 9-18 are pending. Claims 1-4, 15-18 are examined on the merits. Claims 5-8 are canceled.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 22, 2009 has been entered.

Election/Restrictions

Claims 9-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on Aug. 6, 2008.

Applicant's election with traverse of Group I (Claims 1-4, 15-18), the species *Bacillus cereus*, in the reply filed on Aug. 6, 2008 is acknowledged.

Response to Arguments

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Applicant's arguments with respect to claims 1-4, 15-18 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 15-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Agnihotri et al. (1996, Indian J. Experimental Biology, 34, 712-715) and as evidenced by Li (1996, Malawai: Country Report to the FAO International Technical Conference on Plant Genetic Resource, Leipzig).

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Agnihotri et al. teaches cinnamomum zeylanium extracted with hexane and tested for antibacterial properties using gram positive and gram negative bacteria (Abstract). Cinnamomum zeylanium was dried and powdered and mixed with hexane and kept on a rotary shaker for 48 hrs to obtain hexane extract, which was filtered and stored at 10 degree (page 712, right column, paragraph 3). Cinnamomum zeylanium would inherently contain the fruit because the whole plant would include the fruit. The drying process inherently means the extract is dried, where the moisture content is between 5-6% (see Li, page 18, 3.3 Storage Facilities). Hexane has no moisture; therefore, adding hexane to extract does not introduce moisture into the powder. The claims are directed to a composition, the composition would intrinsically have antibacterial activity against *Bacillus cereus* in the range of 200-500 ppm.

The claims are drawn to an antibacterial bioactive composition comprising hexane extract of *Cinnamomum zeylanicum* as the active ingredient therein, within a product-by-process claim.

The cited reference teaches a composition (including in pill/tablet form) consisting of (or consisting essentially of) an extract of *Cinnamomum zeylanicum* as the active ingredient therein which appears to be identical to (and thus anticipate) the presently claimed *Cinnamomum zeylanicum* composition (including inherently comprising the instantly claimed levels of antibacterial bioactive fraction) since both were prepared using similar powdering of *Cinnamomum zeylanicum* extraction and concentration steps (oils were filtered and hexane evaporates because it is a volatile

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liquid). Consequently, the instantly claimed *Cinnamomum zeylanicum* extract composition appears to be anticipated by the cited reference.

In the alternative, even if the claimed *Cinnamomum zeylanicum* extract composition is not identical to the referenced *Cinnamomum zeylanicum* extract composition with regard to some unidentified characteristics, the differences between that which is disclosed and that which is claimed are considered to be so slight that the referenced *Cinnamomum zeylanicum* extract composition is likely to inherently possess the same characteristics of the claimed *Cinnamomum zeylanicum* extract composition particularly in view of the similar characteristics which they have been shown to share. Thus, the claimed *Cinnamomum zeylanicum* extract composition would have been obvious to those of ordinary skill in the art within the meaning of USC 103. Further, if not anticipated, the result-effective adjustment of particular conventional working conditions (e.g., adjusting the concentrate for result-effective amount of the *Cinnamomum zeylanicum* extract beneficially taught by Agnihotri et al. therein) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

Accordingly, the claimed invention as a whole was at least *prima facie* obvious, if not anticipated by the reference, especially in the absence of sufficient, clear, and convincing evidence to the contrary.

Please note that the Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether the *Cinnamomum zeylanicum* extract within Applicant's *Cinnamomum zeylanicum* extract differ and, if so, to what extent, from

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the levels within the red leaf extract disclosed by the cited reference. Therefore, with the showing of the reference, the burden of establishing non-obviousness by objective evidence is shifted to the Applicants.

Please also note that “the patentability of a product does not depend upon its method of production. If the product in [a] product-by-process claim is the same as or obvious from a product of the prior art, [then] the claim is unpatentable even though the prior [art] product was made by a different process.” In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983).

Conclusion

No claim is allowed.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catheryne Chen whose telephone number is 571-272-9947. The examiner can normally be reached on Monday to Friday, 9-5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Catheryne Chen
Examiner Art Unit 1655

/Michael V. Meller/

Primary Examiner, Art Unit 1655